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Blakely Sokoloff Taylor & Zafman LLP
Donna Jo Coningsby
12400 Wilshire Boulevard
7th Floor
Los Angeles, CA 90025

EXAMINER

GREENE, DANIEL L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/541,443

Examiner

Daniel L. Greene

Applicant(s)

DEDRICK ET AL.

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☒ This action is **FINAL**.
- 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/18/2003 have been fully considered but they are not persuasive. Applicant argues that the references cited do not disclose the unique feature of a user/owner of an unused asset loaning their unused asset to another.

The Examiner submits that the user/owner of an unused asset does not uniquely differentiate them from a distributor, a manufacturer or a seller/loaner of an asset. In other words, once a person owns an asset, and the license of the asset permits transference of usage to another, the owner effectively becomes a broker, distributor, etc. of the electronic asset and is treated as such in the art.

In regards to the objection that Robert does not disclose a plurality of user accounts, Robert discloses in Col. 3, " the license data base contains a plurality of entries each containing information ... for a particular licensed program. " (user accounts). As described above, the asset described by the applicant is treated as an electronic asset regardless of how or where it was generated.

In regards to the objection to Wyman not allowing the user of an unused asset to set the license terms, the examiner disagrees. Wyman does in fact provide a variety of alternative styles and contexts in the management of licenses for software product usage.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 12-13, 16-19,21, are rejected under 35 U.S.C. 102(e) as being anticipated by Robert et al. US 4937863 [Robert'863].

As per Claim 1.

Robert'863 discloses an electronic asset lending library database containing a plurality of user accounts and at least one license for an unused electronic assets loaned by a user having one of the plurality of user accounts; Fig. 1, 10

Robert'863 discloses an account manager to maintain the user accounts. Fig. 1,

Art Unit: 3621

Robert'863 discloses an asset manager to maintain the licenses for the unused electronic assets. Fig. 1, **12**

Robert'863 discloses a loan manager to control the borrowing of the unused electronic asset by another user having another one of the plurality of user accounts.

Fig.1, **15**

As per Claim 2.

Robert'863 further discloses:

comprising a notification manger to notify the borrower when the loan manger approves a loan to the borrower of the license for the unused electronic asset. Col. 5, lines 30-68.

As per Claim 3.

Robert'863 further discloses:

the account manager further maintains a subset of the plurality of user accounts as members of a one of a plurality of communities; Fig.1, **17** (group license table)

the asset manager further maintains ownership of the license by one of the communities; Fig. 1, **12** (license unit tables)

the loan manager restricts the borrowing of the license for the unused electronic asset to a borrower having a user account membership in the same community having ownership of the license. Col.4, lines 1-47.

As per Claim 12

Robert'863 discloses ;

managing a plurality of user accounts; Fig. 1, **10** (License Management Facility)

managing at least one license for an unused electronic assets loaned by a user
having one of the plurality of user accounts; Fig. 1, **14** (Licensed Program)

controlling the borrowing of the at least one license for the unused electronic
asset by another user having another one of the plurality of user accounts. Fig.1, **15**
(Licensing Policy Module)

As per Claim 13.

Robert'863 further discloses;

managing the plurality of user accounts includes associating each user account
with a one of a plurality of communities; Col.3, lines 3-25.

managing the license includes associating the license with one of the plurality of
communities and assigning the license to one of the plurality of user accounts. Col. 3,
lines 40-68

As per Claim 16.

Robert'863 discloses;

managing a plurality of user accounts; Fig. 1, **10** (License Management Facility)

managing licenses for a plurality of unused electronic assets; Fig. 1, **14**
(Licensed Program)

Art Unit: 3621

receiving a request from a user of one of the plurality of user accounts to loan another unused electronic asset to another user of another plurality of user accounts;

Fig. 4A-1

generating a license and associated license restrictions for the another unused electronic asset according to the restrictions specified by the user requesting the loan;

Fig. 4A-1

adding the license of the another unused electronic asset to the plurality of managed unused electronic assets; Col. 6, lines 9-60.

and controlling the borrowing of each license for the plurality of unused electronic assets by a borrower having a one of the plurality of user accounts. Col. 6 & 7, lines 1-67.

As per Claim 17.

Robert'863 further discloses;

managing the plurality of user accounts includes associating each user account with a one of a plurality of communities; Col.3, lines 3-25.

managing the licenses includes associating each license with one of the plurality of communities and assigning each license to one of the plurality of user accounts; Col. 3, lines 40-68

and controlling further includes restricting the borrowing to eligible borrowers, wherein an eligible borrower is associated with the same community as the license. Col. 8, lines 4-20.

Art Unit: 3621

As per Claim 18.

Robert'863 discloses;

wherein the one of a plurality of communities is an organizational entity, including a division, department or team. Col.3, lines 3-25.

As per Claim 19.

Robert'863 further discloses;

displaying the plurality of unused electronic assets. Col.3, lines 40-68, Col.4, lines 1-68.

As per Claim 21.

Robert'863 further discloses;

managing the plurality of user accounts includes adding or deleting each user account into at least one of a plurality of access control lists or not; Col. 3, lines 1-67.

managing the license includes associating the unused electronic asset with a one of the plurality of access control lists: Col. 3, lines 1-67

controlling further includes restricting the borrowing to a borrower listed on the access control list to which the electronic asset is assigned. Col. 3 & 4, lines 1-67.

**Claims 22-26, rejected under 35 U.S.C. 102(e) as being anticipated by
Wyman US 5745879 [Wyman'879]**

As per Claim 22.

Wyman '879 discloses:

managing a plurality of user accounts; Col. 6, lines 13-25

generating a license and associated license restrictions for an unused electronic asset on a lending library server, the unused electronic asset loaned by a lender having one of the plurality of user accounts; Col. 6, lines 13-25.

displaying to a borrower having another one of the plurality of user accounts the license and associated license restrictions on a lending library client; Col. 6, lines 39-68, Col. 7 lines 1-5.

receiving a borrower selection for the license and transferring the license to the borrower if eligible in accordance with the associated license restrictions; Col. 6, lines 1-35.

transmitting to the borrower instructions for the installation of the unused electronic asset in compliance with the transferred license on the lending library client. Col. 6, lines 1-35.

As per Claim 23.

Wyman'879 discloses wherein the lending library server and the lending library client are connected to a communications network. Fig. 1,21,22.

As per Claim 24.

Wyman'879 further discloses wherein the associated license restrictions require the borrower to belong to a community, the community being the same community to which the unused electronic asset belongs. Col.22, lines 62-68, Col. 23, lines 1-23.

As per Claim 25.

Wyman'879 further discloses wherein the associated license restrictions further require the borrower to be listed on an access control list associated with the unused electronic asset. Col. 24, lines 3-68.

As per Claim 26.

Wyman'879 further discloses wherein the community is an organizational entity, including a division, department or team. Col. 21, lines 47-68, Col. 22, lines 1-20.

Art Unit: 3621

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5,7-10, 11,14-15,20,27,28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robert et al. US 4937863 [Robert'863], Ginter et al. US 5892900 [Ginter'900] and further in view of Wyman US 5745879 [Wyman'879]

As per Claim 4.

Robert'863 discloses about a license database that contains the terms of the licenses for granting or denying use. Col.3, lines 52-60, but does not specifically disclose the incorporation of an access control lists.

Ginter'900 discloses an Access Control List (ACL) that provide "go/no-go" permissions in an analogous art for the purpose of providing full control over pre-defined and user-defined application events. Col. 85, lines 20-25.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to call Robert'863 license data-base, Ginter'900's Access Control List (ACL) because they both control the use of the various applications.

Robert'863 further discloses the asset manager further maintains an association between the access control list and the unused electronic asset; Col. 6, lines 9-30 and ;

Art Unit: 3621

the loan manager further restricts the borrowing of the license for the unused electronic asset to a borrower having a user account listed in the access control list associated with the unused electronic asset. Col.5, lines 1-10.

As per Claim 5.

Robert'863 discloses wherein the access control list restriction is overridden in response to a request by a borrower not having a user account listed in the access control list associated with the unused electronic asset. Col. 4, lines 48-68, Col. 5, lines 1-10.

As per Claim 7.

Robert ' 863 further discloses about notifying the borrower the status of their license request. Col. 5, lines 1-67.

Ginter '900 discloses as per Fig. 69-69D wherein the borrower notification is an electronic message addressed to the borrower and containing written instructions for installing for downloading the unused electronic asset.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the procedures of Ginter '900 in the notification procedures of Robert ' 863 to facilitate the clarity of the procedure and provide assistance to the user.

As per Claim 8.

Robert '863 further discloses wherein the notification is communicated over a communication network. Col. 3,m lines 15-20.

As per Claim 9.

Roberts '863 discloses the claimed invention, as discussed above, except for the step of wherein the communications network is the Internet. It would have been an obvious matter of design choice to modify the teachings of Roberts '863, to provide the step of wherein the communications network is the Internet. Since the applicant has not disclosed that wherein the communications network is the Internet solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Roberts '863 will perform the invention as claimed by the applicant with any means, method, or product to wherein the communications network is the Internet

As per Claim 10.

Roberts '863 discloses the claimed invention, as discussed above, except for the step of an electronic distribution mechanism to automatically install the unused electronic asset on the borrower's computer in response to the loan approval. It would have been an obvious matter of design choice to modify the teachings of Roberts '863, to provide the step of an electronic distribution mechanism to automatically install the

Art Unit: 3621

unused electronic asset on the borrower's computer in response to the loan approval.

Since the applicant has not disclosed that an electronic distribution mechanism to automatically install the unused electronic asset on the borrower's computer in response to the loan approval solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Roberts '863 will perform the invention as claimed by the applicant with any means, method, or product to provide an electronic distribution mechanism to automatically install the unused electronic asset on the borrower's computer in response to the loan approval

As per Claim 11.

Robert'863 further discloses wherein a community is one of a plurality of types.
Col.3, lines 3-25.

Robert'863 discloses the claimed invention except for the step of discloses wherein a community is one of a plurality of types of intra-organizational entities, including a project team, department, or division. It would have been an obvious matter of design choice to modify the teachings of Robert'863 to provide the step of discloses wherein a community is one of a plurality of types of intra-organizational entities, including a project team, department, or division. Since the applicant has not disclosed that discloses wherein a community is one of a plurality of types of intra-organizational entities, including a project team, department, or division solves any stated problem in a

Art Unit: 3621

new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Robert'863 will perform the invention as claimed by the applicant with any method, means, or product to disclose wherein a community is one of a plurality of types of intra-organizational entities, including a project team, department, or division.

As per Claim 14.

Robert'863 shows lines of communications between the different functions of his invention but does not show displaying the unused electronic assets. However, it is inherent in computer systems to display data.

Robert'863 further discloses reassigning the license of the unused electronic asset to another one of the user plurality of accounts in response to a selection of the unused electronic assets from the display by a borrower using another one of the plurality of user accounts. Col.4, lines 10-68.

As per Claim 15.

Robert'863 discloses;

managing the plurality of user accounts includes adding or deleting each user account into at least one of a plurality of access control lists or not; Fig. 1, **10** (License Management Facility)

managing the license includes associating the unused electronic asset with one of the plurality of access control lists; Col. 6, lines 9-30

controlling further includes restricting the borrowing to a borrower listed on the access control list to which the electronic asset is assigned. Col.5, lines 1-10.

As per Claim 20.

Robert'863 further discloses;

receiving a selection of one of the plurality of unused electronic assets from the display by a borrower using one of the plurality of user accounts, approving a loan of the unused electronic asset, and reassigning the license for the unused electronic asset to the borrower's user account. Col. 3 & 4, lines 1-67.

As per Claim 27.

Robert'863 discloses an electronic asset lending library database (Col.2, lines 63-68, Col. 4, lines 1-25) except for the step of wherein the electronic asset lending library database resides on a removable data storage device. It would have been an obvious matter of design choice to modify the teachings of Robert'863 to provide the step of wherein the electronic asset lending library database resides on a removable data storage device. Since the applicant has not disclosed that wherein the electronic asset lending library database resides on a removable data storage device solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not

Art Unit: 3621

distinguish the invention over similar features in the prior art since, the teachings of Robert'863 will perform the invention as claimed by the applicant with any method, means, or product to wherein the electronic asset lending library database resides on a removable data storage device.

As per Claim 28.

Robert '863 discloses the claimed invention except for wherein the data storage device is a CD-ROM or a DVD-ROM. Wyman '879 teaches that it is known in the art to provide wherein the data storage device is a CD-ROM or a DVD-ROM. Col. 9, lines 49-60.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the electronic asset lending library of Robert '863 with the data storage device as a CD-ROM or a DVD-ROM of Wyman'879, in order to provide flexibility in the system.

Art Unit: 3621

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

In regards to the subject matter proposed in the application, an issue was brought up during the discussion of the merits of the Amendment and the case.

Loaning a licensed software program may be infringing on the copyright laws governing intellectual property. There are some programs where the license specifically permits the user to transfer the use of the asset. There are other programs where the license specifically states that the use of the product cannot be transferred or used by any one else except the original purchaser and their designated subsidiaries. The Patent Corp does not provide opinions on the legality of an application. However, when an issue is raised, special examination and revue is instituted.


Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communication. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113. DLG
April 17, 2003


JOHN W. HAYES
PRIMARY EXAMINER